



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/901,954	07/10/2001	James E. Templeton	PAY00-003	7267
22200 7590 02/13/2007 PARK, VAUGHAN & FLEMING LLP P.O. BOX 7865 FREMONT, CA 94537			EXAMINER NGUYEN, NGA B	
			ART UNIT	PAPER NUMBER
			3692	

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	02/13/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

09/901,954

Applicant(s)

TEMPLETON ET AL.

Examiner

Nga B. Nguyen

Art Unit

3692

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 May 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-43 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-43 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This Office Action is the answer to the Appeal Brief filed on May 11, 2006, which paper has been placed of record in the file.
2. Claims 1-43 are pending in this application.

Response to Appeal Brief

3. In view of the Appeal Brief filed on May 11, 2006, PROSECUTION IS HEREBY REOPENED. A new ground of rejections is set forth below.
4. To avoid abandonment of the application, appellant must exercise one of the following two options:

(1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office action is final); or,

(2) initiate a new appeal by filing a notice of appeal under 37 CFR 41.31 followed by an appeal brief under 37 CFR 41.37. The previously paid notice of appeal fee and appeal brief fee can be applied to the new appeal. If, however, the appeal fees set forth in 37 CFR 41.20 have been increased since they were previously paid, then appellant must pay the difference between the increased fees and the amount previously paid.

A Supervisory Patent Examiner (SPE) has approved of reopening prosecution by signing below:


JAMES P. TRAMMELL
SUPERVISORY PATENT EXAMINE
TECHNOLOGY CENTER 3600

Claim Rejections - 35 USC § 112

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 1-12 and 25-28 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 1-12 and 25-28 are ***ambiguous*** because they include both product and process. A single claim which claims both an apparatus and the method steps of using the apparatus is indefinite under 35 U.S.C. 112, second paragraph. In *Ex parte Lyell*, 17 USPQ2d 1548 (Bd. Pat. App. & Inter. 1990), a claim directed to an automatic transmission workstand and the method steps of using it was held to be ambiguous and properly rejected under 35 U.S.C. 112, second paragraph.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 1-43 are rejected under 35 U.S.C. 103(a) as being unpatentable over Talati et al (hereinafter Talati), U.S. Patent No. 5,903,878

Regarding to claim 1, Talati discloses within a system comprising: a user interface configured to exchange communications with users and a transaction processor coupled to one or more financial systems (see figure 3, Transaction Administrator 60), a computer-implemented method of verifying a customer's authority to use a financial instrument, comprising:

storing one or more attributes (column 5, lines 33-40 and column 6, lines 25-32, the transaction administrator 60 stores originator's information, e.g. mother's maiden name, social security number, driver's license number, etc.);

receiving a set of proffered attributes (column 5, lines 33-40 and column 6, lines 25-32, the transaction administrator receives the answers to the series of questions from the originator);

comparing said proffered attributes to said stored attributes (column 6, lines 33-36, the CA 60 responds with an authorization for the transaction if there is a confirmation by client of transaction validity); and

accepting use of the financial instrument by the customer for a subsequent transaction if said proffered attributes match said stored attributes (column 6, lines 33-36, the CA approves the client transaction if there is a confirmation by client of transaction validity).

Talati does not disclose the transaction processor configured to initiate one or more transactions using a financial instrument identified by a customer, storing one or more attributes of said one or more transactions. However, such features are well known in the art of maintaining and processing financial transactions at a credit

authority (e.g. credit card issuer, bank, etc). For example, the conventional credit card system maintains transaction history includes one or more previous transactions conducted by a cardholder, the previous transaction contains one or more attributes such as amount of transaction, merchant identifier, date/time of transaction, etc, The conventional system is also capable of retrieving (or initiating) the one or more of previous transactions for specific purposes (reviewing, tracking, auditing, etc). Thus, it is obvious that the conventional credit card system configured to initiate one or more transactions using a financial instrument identified by a customer. Moreover, Talati discloses the series of questions may be constantly changed such that an unauthorized user would not be able to predict what information the CA 60 might ask for (column 6, lines 25-32). Therefore, it would have been obvious to one with ordinary skill in the art at the time the invention was made to modify "the series of questions" of Talati's to add "one or more attributes of one or more previous transactions" in "the series of questions" queried by the transaction administrator, for the purpose of allowing the transaction administrator query the client one or more attributes of one or more previous transactions in order to provide additional security when processing transactions using a financial instrument.

Regarding to claim 2, Talati discloses after said initiating, soliciting said proffered attributes from the customer (column 5, lines 35-40).

Regarding to claims 3-7, Talati does not disclose wherein said initiating comprises: initiating a first transaction involving the financial instrument with a first set of attributes; and initiating a second transaction involving the financial instrument with a

Art Unit: 3692

second set of attributes different from said first set of attributes; wherein said storing attributes comprises storing a value of a first transaction in said one or more transactions, a merchant identity of a first transaction in said one or more transactions, the number of said one or more transactions; wherein said storing attributes comprises storing a type of one of said one or more transactions. However, such features are well known in the art of maintaining and processing financial transactions at a credit authority (e.g. credit card issuer, bank, etc). See claim 1 above for the same motivations.

Regarding to claim 8, Talati discloses wherein said initiating comprises operating a transaction processor to electronically initiate said transactions (column 4, lines 45-50, the originator 50 initiates a transaction using processor 70).

Regarding to claim 9, Talati discloses wherein said receiving comprises electronically receiving said proffered attributes (column 8, lines 17-47).

Regarding to claims 10-12, Talati discloses wherein the financial instrument is a credit card, a debit card, or a bank account (column 4, lines 55-57).

Claims 13-24 have similar limitations found in claims 1-12 above, therefore, are rejected by the same rationale.

Claims 25-26 have similar limitations found in claims 1, 5 above, therefore, are rejected by the same rationale.

Claims 27-28 have similar limitations found in claims 1, 4 above, therefore, are rejected by the same rationale. Moreover, Talati discloses a bank account includes an account number and routing number (column 7, lines 25-45).

Claim 29 is written in computer software that parallel the limitations found in claim 1 above, therefore, is rejected by the same rationale.

Regarding to claim 30, Talati discloses a system for verifying a user's authorization to user an external financial account, comprising:

- a transaction processor (column 4, lines 45-57; an originator 50 initiates a transaction using processor 70, the originator identity may comprise a credit card number, account number, etc.);

- a memory configured to store a first set of details of said transactions (column 4, lines 58-60; the processor 70 is a personal computer, note that a personal computer always includes a memory; column 5, lines 15-20 and figure 50; the originator 50 stores a list 100 includes the UTID, the amount, parities, etc. associated with each transaction generated by the originator);

- a user interface configure to receive a test set of details (column 4, lines 58-65);

and

- a processor configures to compare said first set of details and said test set of details (column 5, lines 15-20, the originator compares the UTID with a list 100 generated by the processor 70).

Talati does not disclose the transaction processor configured to initiate one or more transactions involving an external financial account identified by a user, a test set of details independent of any transaction involving the external financial account, the test set of details after said transactions have been completed. However, such features are well known in the art of maintaining and processing financial transactions at a credit

authority (e.g. credit card issuer, bank, etc). See claim 1 above for the same motivations.

Regarding to claim 31, Talati discloses said processor is further configured to authorize the user to user the external financial account if said test set of details matches a predetermined subset of said first set of details (column 5, lines 20-25).

Regarding to claim 32, Talati discloses where said transaction processor is coupled to an ACH (Automated Clearing House) transaction handler (column 8, lines 1-15).

Regarding to claims 33-35, Talati discloses where said transaction processor is coupled to a credit card service provider which is merchant acquirer, a credit card gateway provider (column 5, lines 50-67 and figures 3-6; a credit card transaction between a client 50, merchant 55 and credit authority 60).

Regarding to claim 36, Talati discloses where said transaction processor is configures to construct said one or more transactions prior to their initiation (column 4, lines 45-57).

Regarding to claim 37, Talati discloses a computer server for operating said user interface (column 4, lines 58-65).

Regarding to claim 38, Talati discloses wherein said computer server is further configured to construct said one or more transactions prior to their initiation by said transaction processor (column 4, lines 45-65).

Claims 39-41 are written in means that contain similar limitations found in claims 30, 31 above, therefore, are rejected by the same rationale.

Regarding claims 42-43, Talati discloses receiving the subsequent transaction, the subsequent transaction identifying a destination; the subsequent transaction identifying a source (column 5, lines 1-13). Talati does not disclose transferring funds from the financial instrument to the destination and transferring funds to the financial instrument from the source. However, transferring funds from/to financial instrument to/from the destination/source is well known in the art. Therefore, it would have been obvious to one with ordinary skill in the art at the time the invention was made to modify Talati's to include the feature above, for the purpose of allowing funds transfer using financial instrument.

Conclusion

9. Claims 1-43 are rejected.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to examiner Nga B. Nguyen whose telephone number is (571) 272-6796. The examiner can normally be reached on Monday-Thursday from 9:00AM-6:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richard E. Chilcot can be reached on (571) 272-6777.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (571) 272-3600.

11. Any response to this action should be mailed to:

Art Unit: 3692

Commissioner of Patents and Trademarks

C/o Technology Center 3600

Washington, DC 20231

Or faxed to:

(571) 273-8300 (for formal communication intended for entry),

or

(571) 273-0325 (for informal or draft communication, please label

"PROPOSED" or "DRAFT").

Hand-delivered responses should be brought to Knox building, 501 Dulany
Street, Alexandria, VA, First Floor (Receptionist).



NGA NGUYEN
PRIMARY EXAMINER

December 11, 2006